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PATENT TRADEMARK OFFICE

Patent
Case No.: 48317US030

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: JAPUNTICH, DANIEL A.

Application No.: 09/678580

Group Art Unit: 3761

Filed: October 3, 2000

Examiner: Aaron J. Lewis

Title: FIBROUS FILTRATION FACE MASK HAVING A NEW
UNIDIRECTIONAL FLUID VALVEFAX RECEIVED
MAY 27 2003
GROUP 3700**REPLY BRIEF**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF TRANSMISSION

To Fax No.: 703-872-9303

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on:

May 27, 2003

Date

Signed by: Susan M. Dacko

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed March 25, 2003.

Because much of the argument presented by the Examiner in the Examiner's Answer has already been addressed in applicants' Appeal Brief, there is no need to further reply to those positions. Applicants have found, however, four new points of argument that have been raised by the Examiner, and each of these points of argument are addressed below as follows:

1. The Examiner maintains and further elaborates on the position that the Simpson valve would remain closed under any orientation of the mask.

On page 13 of the Examiner's Answer, the Examiner states the following:

One of ordinary skill presented with the entire Simpson et al. patent especially including the abovementioned passages would realize that the only way for the mask of Simpson et al. to operate as intended (i.e. filter out harmful atmosphere) would be if the exhalation valve flap (15) remained closed except during exhalation. There is no disclosure in Simpson et al. which would lead one of ordinary skill to any other conclusion. The disclosure within Simpson et al. which relates to the operation of the valve flap (15) expressly discloses that it opens during exhalation. There is no disclosure of valve flap (15) moving to its open position at any other time nor at any particular orientation of the mask as it is worn by a user. All affidavits submitted by appellants on this issue have been addressed herein above.

Application No.: 09/678580

Case No.: 48317US030

This position is erroneous for a number of reasons. Firstly, the record does not include any evidence that a person of ordinary skill would interpret the Simpson et al. patent as held by the Examiner. Indeed, the record reflects precisely the opposite. Applicants have submitted Affidavits and Declarations of persons who are skilled in the field of designing exhalation valves. None of these skilled artisans have interpreted the Simpson patent as indicated by the Examiner. Thus, applicants are at a loss to understand how the Examiner can state that "[o]ne of ordinary skill presented with the entire Simpson et al. patent especially including the abovementioned passages would realize that the only way for the mask of Simpson et al. to operate as intended (i.e. filter out harmful atmosphere) would be if the exhalation valve flap (15) remained closed except during exhalation." Further, contrary to the Examiner's stated position, there is a disclosure in Simpson that does lead to another conclusion. At page 1, lines 58-64, Simpson states that its valve may leak and accordingly suggests the use of an "antechamber" to prevent the inhalation of "harmful atmosphere". Simpson's suggestion of an entirely different structure for preventing contaminant inflow shows that the Examiner's position is not correct. This disclosure also presents very good evidence that applicants' invention would not have been obvious to a person of ordinary skill. Applicants' invention does not need to use an "antechamber" to preclude contaminants from entering the mask interior. Applicants have achieved this result through use of a valve cover that is disposed over the valve seat and that comprises a surface that mechanically holds the flexible flap against the flap-retaining surface, wherein the flexible flap is held against the flap-retaining surface and is positioned relative to the seal surface such that the flap is pressed towards the seal surface in a substantial abutting relationship therewith under any orientation of the valve when a fluid is not passing through the orifice.

The Examiner has yet to identify where Simpson or Shindel provide a disclosure of this feature of applicants' invention. Both Simpson and Shindel fail to teach or suggest a structure where the flap is pressed towards the seal surface in a substantial abutting relationship therewith under any orientation of the valve when a fluid is not passing through the orifice. Both references also fail to teach or suggest holding the flexible flap against the flap-retaining surface and positioning it relative to the seal surface to enable the flap to be pressed against the seal surface as recited above. The Examiner, therefore, relies on the unsupported proposition that "one of ordinary skill...would realize these features of the applicants' invention. The record,

Application No.: 09/678580

Case No.: 48317US030

however, contains no evidence to support this so-called "realization" that the Examiner speaks of. As the Board is aware, bold conclusions that are not supported by the record cannot properly be used to sustain obviousness rejections under the terms of 35 USC § 103.

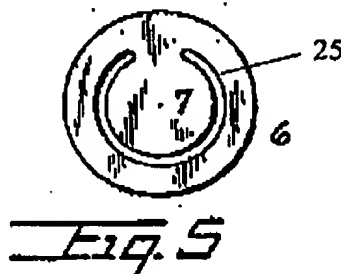
2. The Examiner asserts that Shindel describes a structure that causes the flexible flap to be pressed towards the seal surface in a substantial abutting relationship with it under any orientation of the valve.

The Examiner takes the position that Shindel does describe a structure that satisfies all limitations of applicants' claimed invention. In particular, the Examiner states:

Appellants' assertion that Shindel lacks a structure which causes the flexible flap to be pressed against a seal surface is not accurate. Shindel (page 1, lines 51-55) expressly disclose interior offsets (14) which press the rim portion (6) of the valve to its seat (5).

The Examiner, in taking this position, is improperly interpreting the scope and content of Shindel. As indicated above and in applicants' Appeal Brief, the present claims require that the flap be pressed towards the seal surface in abutting relationship with it.

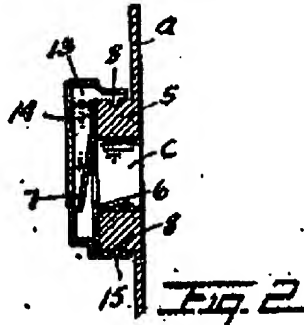
Shindel's valve has a rim portion 6 that surrounds flap 7:



A cut-out, identified by applicants' attorney using number 25 is provided in the valve. Because Shindel's valve is mounted on a circular boss 5 (see Fig. 2 below), and because Shindel's valve seat is in direct alignment with the point of mounting like Simpson, Shindel also does not present a structure that would cause flap 7 to be pressed towards the seal surface in an abutting relationship with it:

Application No.: 09/678580

Case No.: 48317US030



The Examiner nonetheless states that the interior offsets 14 would press the rim portion 6 of the valve to the seat 5. The rim portion 6 of the valve, however, is not the flap, and this is where the Examiner misinterprets the scope and content of McKim. The flap is identified in Shindel by numeral 7. A review of Shindel reveals that the rim portion 6 is stationary and does not move or bend. The fact that it may be pressed against the seal surface is of no significance. The flap 7 can only dangle freely in front of the opening C in Shindel's valve.

3. The Examiner states that applicants' arguments regarding the '698 patent to Magidson et al. are not relevant.

In disregarding applicants' arguments regarding the '698 Moldex patent, the Examiner states that the reasons for issuing the '698 patent are not pertinent to the patentability of the subject matter on appeal:

Appellants' arguments regarding the Magidson et al. ('698) patent are irrelevant to the issues in the instant application because the reasons for issuance are not part of the record of the instant application and cannot be employed to support nor refute positions taken in this case. The similarities between the mask and exhalation valve structure as pointed out by appellants is noted; however, there are structural differences which differ from the instant invention thereby making its discussion here irrelevant to the issues at hand.

This statement reveals that the Examiner has wholly misinterpreted applicants' argument and apparently has not given due consideration to the evidence of copying. Nowhere have the applicants argued that the Examiner should allow this case because the '698 patent also issued (see pages 18-20 of applicant's Appeal Brief). Applicants have referred to the '698 patent because it demonstrates that the technology of the present invention has been copied by other persons skilled in the art after publication of applicants' invention. As the Board is aware, evidence of copying presents very good evidence of nonobviousness. Because the Examiner

Application No.: 09/678580

Case No.: 48317US030

believes that applicants have cited the '698 patent for an entirely different purpose, it is clear that the Examiner has not properly considered the evidence of copying. Section 103, of Title 35, requires that the subject matter "as a whole" be considered in making a patentability determination. The Examiner's failure to properly consider this evidence of copying is a legal error.¹

4. The Examiner states that the issue of whether McKim constitutes nonanalogous art has been settled in a previous decision.

In holding that McKim describes analogous art, the Examiner states the following:

It is noted that the question of whether McKim constitutes non-analogous art has been addressed and settled in an appeal to the Board of Appeals in appellants' related application 08/240,877 in which the Board of Appeals upheld the combination of McKim with other prior art references including Simpson et al.

This position is erroneous for a number of reasons. Firstly, no argument was made in the '877 application as to whether McKim constitutes nonanalogous art. Therefore, the Board never addressed the issue. Because the Board never addressed the issue, the Examiner is entirely incorrect in stating that the issue had been addressed and settled in an earlier appeal. Secondly, the claims that were presented in application Serial No. 08/240,877 are not the same claims that are present in this appeal. Thirdly, the record in the '877 case did not include the expert testimony of Castiglione, Bowers, Fabin, and Betts. Therefore, the factual record is also different. The Examiner's reliance on this earlier Decision that did not address the issue of analogous art, that presented different claims on appeal, and that did not include the evidence that is presently of record constitutes clear legal error. It also misrepresents the prosecution history of the '877 application.

¹ *In re Sernaker*, 217 USPQ 1, 7 (Fed. Cir. 1983) ("If, however, a patent applicant properly presents evidence relating to these secondary considerations, the board must always consider such evidence in connection with the determination of obviousness."); see also *W.L. Gore & Assoc. Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983) ("As discussed more fully below, the district court erred in specifically declining to consider the objective evidence of nonobviousness."); Manual of Patent Examining Procedure 2100-90 (Feb. 2000).

Application No.: 09/678580

Case No.: 48317US030

For the reasons presented above, in conjunction with those presented in applicants' Appeal Brief, the holding of obviousness should be reversed.

Respectfully submitted,

May 27, 2003

Date

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